

REMARKS

Reconsideration of this application is respectfully requested. Claims 1, 2 and 5-15 as amended remain in the case and are again presented for consideration. Claim 1 has been further amended to restate the clear distinctions that characterize the present invention, particularly when considered in light of the cited prior art.

Particularly, two salient aspects of amended claim 1 bear careful review. The first aspect and distinction is found in lines 14-17 of the claim, where an explicit recitation is now present, that there is direct attachment of the leading edge (42A) of the label to the product container surface while the remainder of the label is still attached to the single layer web (36) and before the label is detached, so that the relative movement of the product container with respect to the label functions to detach the label from the rest of the web, so that it can then complete its application to the product container. This feature is clearly not shown or suggested by the cited prior art.

The second aspect is found in the passage now appearing in lines 20-23, that the detachment of the label from the remainder of the web is conducted without making any changes in the label as it moves while still attached to the web, to attachment to the product container. Once again, this is in clear distinction to the teachings of both of the cited references, where separate apparatus other than that supporting and moving the web and the product container, is required to sever the label from the remainder of the label stock, prior to the movement of the label to the next station, or to its application to a product surface.

Additional amendments include the correction in the dependency of claims 11 and 14, to refer to claim 1 instead of claim 3. Favorable consideration and withdrawal of the rejection under 35 U.S.C. §112 as to these claims is believed to be warranted, and is requested.

Claim Rejections – 35 USC §112

Claims 11 and 14 has been rejected under 35 U.S.C. §112, second paragraph, due to their

dependence on a canceled claim. The amendment of these claims is believed to overcome this rejection, and withdrawal thereof is requested.

Claim Rejections – 35 USC §103

Claims 1, 2, 6 and 8 have been rejected under 35 USC § 103(a) over Boreali (US 5,573,621), in view of newly cited Bekker-Madsen (US 5,112,427). As this rejection may pertain to the claims as amended, it is traversed.

The following discussion of Boreali is repeated from applicant's prior response, as it remains relevant to the consideration of the examiner's current remarks. Accordingly, Boreali concerns the processing of what the patentee calls 'non-quadrate' single-ply labels, and by 'non-quadrate' the patentee intends labels that are circular, oval, triangular, etc. and thus not square or rectangular (column 1, lines 8-10). Moreover, the labels in Boreali are designed and manufactured to be connected in a 'string', with the 'string' or connection being specifically about 0.018-0.030 inches in width (column 3, lines 43, 61 and 66). By contrast, the present system and method imposes no such size limitation on either the shape of the labels, or the size of the connections between adjacent label units. This distinction is important as the remainder of the reference is considered.

The Boreali method and system employs three stages of operation. The first is to remove the waste material which surrounds the labels, the second operation is to remove the leading label from the remaining strip of labels and the third operation is to move the *separated* label for subsequent application. The first operation is achieved as shown with regard to Figure 5 and accompanying description, in which there is provided a guide 22 which guides the strip of labels onwards, with the waste material 17 being led upwards as indicated by arrow 30 to be separated from the strip of labels. It is this stage of the Boreali method that continues to be a relevant distinction from the present method.

To reiterate, at this stage of the Boreali method, the strip of labels remains intact and indeed there is no possibility of the leading label being separated, as there is no apparatus

provided to do so. This therefore means that in Boreali, downstream of the matrix separation, apparatus for the second operation is required to be provided. This apparatus comprises bursting rollers 34, 35 and a blade 36. This operation separates the leading label and even then, further apparatus is required in order to grab and move the separated leading label for subsequent use. Examples of this apparatus are provided in Figures 7-13 of the reference.

Applicant hastens to point out, that no such apparatus is either necessary or is provided in the practice of the present method, and that instead, the relative movement of the lead label, already attached to the product container at its forward edge, in relation to the remainder of the label web, results in the severance of the lead label therefrom and its freedom for subsequent movement into complete adhesive contact with the product container surface. Language emphasizing this aspect of the system and corresponding method, has been introduced into claim 1 at lines 20-23 of claim 1.

In summary, Boreali provides and requires three stages of operation using three different sets of apparatus. The examiner has selected to refer to the first stage only, which does not disclose the current invention of claim 1. The examiner then states that it would be obvious to a skilled person reading Boreali to remove all of the apparatus of stages 2 and 3 and then refers to Bekker-Madsen, to provide the requisite teaching. At this juncture, a review of Bekker-Madsen is in order.

The examiner's current remarks rely on Bekker-Madsen for the teaching that the labels may be "... (placed) directly onto the surface of a product container." Applicant concurs with the remainder of the examiner's statement at this juncture, as she points out that the art (Boreali) teaches the placement of "... *detached* labels on the surface of a product container." Once again, this is in distinction to the instant method, particularly as presently claimed, where the labels are *placed on the surface of (the) product container*, while still **attached** to the remainder of the labels in the web.

Considering further the disclosure of Bekker-Madsen, this reference concerns a system where a strip of labels is pre-punched with selected portions retained (referred to as 'adhesive

bridges'). In Bekker-Madsen, as in Boreali, the labels reach a station where they are to be readied for application to a container, and at this station they are completely severed from the skeleton of the web. The thus severed labels are then applied by separate mechanisms, such as pressurized air following retention in position by suction.

Importantly, it is clear from Bekker-Madsen that the label is required to be separated from the remainder material before the label is applied to the product container. For example, in column 5, lines 34-36, the label which is to be applied to the container, is stated as being separated and so the label is completely released from the backing material strip and, in column 7, lines 5-14, it is clear that the individual labels are released from the skeleton material strip by the use of punchers or cutters to break the remaining bridges between the label and the other material. In contrast, in the current invention, there is no need to provide punchers, cutters or any other removal device as it is the adherence of the protruding edge of each of the labels on the product container to which the same is to be applied, which causes the remaining bridges between the leading label and the other labels and material to be broken.

As a further point of distinction, in Bekker-Madsen, the adhesive to form the label, is not applied until the label is removed from a backing strip and the label has reached the labeling position; see, for example, column 2, lines 65-69 of the reference. In contrast and as now clearly set out in claim 1 as amended, the label which is applied is a self adhesive label in the current invention and furthermore, no change in condition is required to be performed on the label between movement from the web to the product container. Thus, the label in Bekker-Madsen, is quite clearly not a self adhesive label in the same form as currently claimed. Further, while column 3 of Bekker-Madsen, at lines 10-15, suggests that an inactive adhesive may be provided on the label at all times, there is still required to be performed an action which renders the inactive adhesive, active, before application to the product.

In the present invention it has been identified that it is possible to apply the leading end of the leading label to the product container while still connected to other labels and the surrounding matrix and to allow the relative movement between the container and label to cause

both the separation of the label from the web material and the remaining labels at the same time. This therefore removes the need for two stages of operation of the Boreali method, and achieves a result which cannot be achieved in Bekker-Madsen.

Accordingly, applicant submits that the rejection as it may be based on Boreali in view of Bekker-Madsen is rendered moot by the presentation of the claims as amended, and by the foregoing distinguishing remarks, so that the rejection as it may be based on 35 USC §103(a) is believed to be overcome and withdrawal thereof is requested.

Claim 5, 10, 11 and 12 have been rejected under 35 USC §103(a) as unpatentable over newly cited Boreali in view of Bekker-Madsen, and further in view of Jeffries (US 3,880,692). As this rejection may pertain to the claims as amended, it is traversed.

In similar fashion to the analysis of Jeffries and Boreali in the prior filed response, the former reference likewise fails to cure the deficiencies of the latter even in combination with Bekker-Madsen, as Jeffries concerns itself with the application of adhesive to a surface of a label. In other respects, however, Jeffries fails to disclose that a web of single ply construction bearing a series of labels, all as set forth in claim 1 as amended, could be prepared and used in a method for direct application to a product. Thus, assuming *arguendo*, that the combination of Jeffries, Boreali and Bekker-Madsen et al. is proper, which applicant submits, is not so, it still fails from a factual standpoint, to provide the necessary suggestion to the artisan that the present method as claimed could be arrived at and practiced. For this reason, therefore, the rejection as it may pertain to the combination of Boreali, Bekker-Madsen et al. and Jeffries is believed to be overcome, and withdrawal thereof is requested.

Claim 9 has been rejected under 35 USC Section 103(a) as unpatentable over Boreali in view of Bekker-Madsen, and further in view of West et al. (US 5,275,678). As this rejection may pertain to the claims as amended, it is traversed.

The deficiencies of Boreali and Bekker-Madsen have been pointed out with respect to the rejections discussed above, and such comments are reiterated and incorporated herein. Like Jeffries, West et al. fails to cure the deficiencies of the primary references, as the same teachings

that are missing from the primary references are not supplied by this secondary reference. West et al. is directed to a means by which labels bearing adhesive are treated prior to application so that the adhesive will operatively secure the labels onto containers. There is, however, no disclosure in West et al. of the construction of the labels of the present invention or the specific method by which they are dispensed and conveyed directly into contact with the product container surface. Thus, the combination of West et al. with Boreali and Bekker-Madsen et al. remains deficient and does not provide the requisite teaching to the artisan to arrive at the present invention. Accordingly, withdrawal of the rejection as it may be based on West et al., Boreali and Bekker-Madsen is believed to be in order, and is requested.

Claim 7, 13, 14 and 15 have been rejected under 35 USC Section 103(a) as unpatentable over Bekker-Madsen in view of Osaka (US 6,030,482). As this rejection may pertain to the claims as amended, it is traversed.

Once again, the comments with respect to Bekker-Madsen recited above are incorporated herein by reference and made a part hereof. The deficiencies of Bekker-Madsen are not remedied by Osaka, as Osaka relates only to the application of a silicone layer over the printing or first surface of a label, to act as a release material. There is no disclosure in Osaka of the single layer construction of the present web or the means by which the present labels are directly applied to product containers while still connected to the remainder of the labels. Thus, the rejection as it may be based on the combination of Bekker-Madsen and Osaka is believed to be deficient and overcome, and withdrawal thereof is likewise requested.

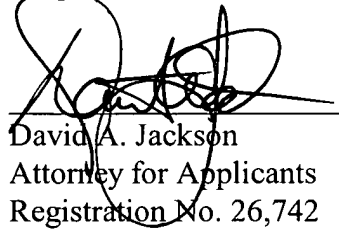
Conclusion

To summarize, therefore, the features of the present method are believed to be more clearly recited in the redraft of claim 1, and upon a review of same, the patentable distinctions between the claim and that of the primary references to Boreali and Bekker-Madsen et al. are made manifestly apparent. Thus, applicants believe that patentable subject matter has now been clearly defined and that all grounds of rejection have been overcome. Should the Examiner

believe that other issues remain for resolution, she is invited to call the undersigned at the number listed below.

In view of the above and foregoing, reconsideration and withdrawal of the outstanding grounds of objection and rejection and early allowance of the claims as amended is believed to be in order and is courteously solicited.

Respectfully submitted,



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ENCLOSURES: Request for three (3) Month Extension of Time
Check No. 5162 in the amount of \$555.00